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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,028	02/14/2005	Gerd Roland Meyer	2001DE451	5175

25255 7590 07/01/2005

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EXAMINER	
PEZZUTO, HELEN LEE	
ART UNIT	**PAPER NUMBER**
1713	

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/500,028	MEYER ET AL.	
	Examiner	Art Unit	
	Helen L. Pezzuto	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 June 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/15/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Applicant's amendment to claims 1-20, and the addition of claims 21-51 filed in the preliminary amendment on 6/22/04 is acknowledged. Currently, claims 1-51 is pending in this application.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11, 32 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, the recited "preferably" and "particularly preferably" render the claim indefinite as a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) resulting in a claim which does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is

followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In claims 32 and 34, the recited methacrylic acid does not further limit the scope of the macromonomer in the preceding claims. Please clarify.

In claim 26, does applicant intend the first occurrence of R^3 to be "sec-butyl alkylphenyl" rather than "sec butyl" residue?

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkins (US-841) or Stockhausen et al. (US-789) or Morschhauser et al (US-838) in view of WO 00/60942 (with respect to claims 15-16).

US 5,639,841 to Jenkins discloses a process of producing water-soluble polymers, derived from 1-99.8 wt% of one or more nonionic, cationic, anionic, amphoteric monomers, and one or more monoethylenically unsaturated macromonomers (col. 1, line 49 to col. 2, line 13). Suitable anionic monomer include the instant A) and/or its salts (col. 3, lines 4-7) as defined in the present claims. Prior art macromonomer embraces the instant macromonomer B) as expressed structurally in the present claims (col. 4, line 1 to col. 6, line 26), wherein prior art R^1 corresponds to the instant R^3 (col. 6, lines 6-17). Furthermore, a crosslinking monomer may be incorporated (col. 6, lines 27-60). The resultant polymer is taught to be suitably used as dispersant and thickener in agricultural chemicals. Closely analogous WO 00/60942 specifically teaches a water dispersible solid granular agricultural chemical composition containing the instant pesticdal active substance expressed in claims 15-16. Accordingly, it would have been prima facie obvious to one skilled in the art to select 2-acrylamido-2-methylpropane sulfonic acid and/or its salt and a macrmonomer among those

expressively disclosed in the prior art to form a dispersant polymer used in an agricultural chemical composition containing the specific pesticidal active substance expressed in claims 15-16, motivated by the reasonable expectation of success as taught in the references. Once the general conditions of a claim are suggested, discovering the optimum or workable ranges would involve only routine skill in the art.

US 5,837,789 to Stockhausen et al. discloses a fluid-absorbing polymer suitably used in agricultural application (i.e. raising plants) (abstract, col. 9, lines 30-31). Prior art polymer comprises 55-99 wt% of ethylenically unsaturated acid monomers, inclusive of 2-acrylamido-2-methyl propane sulfonic acids and/or its salts (col. 7, lines 28-43) and a crosslinking monomer mixture defined by formula I, II, and III. The instant macromonomer falls within the scope of prior art II as defined in the reference. As stated in the preceding paragraph, it would have been obvious to one skilled in the art to select 2-acrylamido-2-methylpropane sulfonic acid and/or its salt and a macrmonomer among those expressively disclosed in the prior art to form a fluid-absorbing polymer suitably used in an agricultural chemical composition containing the specific pesticidal active substance expressed in claims 15-16, motivated by the reasonable expectation of success as taught in the

references. Once the general conditions of a claim are suggested, discovering the optimum or workable ranges would involve only routine skill in the art.

US 2004/0109838 to Morschhauser et al. disclose a copolymer composition comprising the instant essentially components in the present amounts. Prior art specifically teach the utility of the resultant copolymer composition as thickener in crop protection compositions ([0002], [0125]). Accordingly, one skilled in the art would readily envisaged selecting 2-acrylamido-2-methylpropane sulfonic acid and/or its salt and a macrmonomer among those expressively disclosed in the prior art to form a thickener polymer used in a crop protection composition containing the specific pesticidal active substance expressed in claims 15-16, motivated by the reasonable expectation of success as taught in the references.

5. Claims 1-51 are rejected under 35 U.S.C. 103(a) as being obvious over Morschhauser et al. (US-476) The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of

this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

U.S. 6,645,476 B1 to Morschhauser et al. discloses water-soluble polymer prepared by free radical polymerization of one or more ethylenically unsaturated monomers and one or more macromonomers as defined in the present claims. Suitable monomer include AMPS and salts thereof, and various comonomers within the scope of the present claims. Suitable macromonomers include polyglycol ethers and (meth)acrylates, which fall within the scope of the instant macromonomer. Prior art further teaches using precipitation polymerization in t-butanol (col. 4, line 66). In a preferred embodiment, crosslinked polymers are taught

(col. 4, lines 16-29). The use of polymeric derivatives as emulsifiers/thickener in crop protection formulation is expressively disclosed (col. 10, lines 18-34). Antimicrobially effective agents, inclusive of fungicidal active ingredients are disclosed as additives (col. 7, lines 65-66; col. 8, line 64 to col. 9, line 2). Accordingly, since prior art discloses the process of producing water-soluble polymer within the requirement of the present claims, one skilled in the art would have been motivated to select AMPS and/or salt, copolymerize with a macromonomer as taught to form applicant's plant protection formulation, motivated by the reasonable expectation of success.

6. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blankenburger et al. (US-074) or Mathauer et al. (US-318) or Morschhaeuser et al. (US-998).

US 6,403,074 B1 to Blankenburg et al. discloses a free-radical polymerization process for preparing a water-soluble/dispersible polymer. Prior art process teaches polymerizing one or more ethylenically unsaturated monomers (a) (i.e. acrylamidopropanesulfonic acid and/or its salts) in the presence of a polyalkylene oxide-containing silicone derivates (b) which reads on the instant macromonomer (col. 4, line 42; col. 6, lines 46-53).

US 6,727,318 B1 to Mathauer et al. discloses a free radical emulsion polymerization process of preparing a dye-comprising aqueous dispersion, comprising anionic (i.e. salts of (meth)acrylamido-2-methylpropanesulfonic acid), cationic monomers, non-ionic monomers, and macromonomers (col. 4, line 4 to col. 5, line 24) as in the recited claims. Accordingly, prior art disclosure renders the selection of the recited monomer component to form applicant's copolymer readily envisaged by one of ordinary skill in the art, motivated by the reasonable expectation of success.

US 2005/0032998 discloses the instant copolymer containing AMPS and/or salt thereof in the instant proportions, and prepared by the instant polymerization process.

The intended use language recited in the preamble is not afforded the effect of a distinguishing limitation because the body of the claim does not set forth limitation that refers to the environment or use specified in the preamble.

Double Patenting

7. Claim 49 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 8-18 of copending Application No. 10/433,006. Although the conflicting claims are not identical, they are not patentably distinct from each other because the

instant formulation is generic to and fully encompass that in the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claim 49 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 9-27, 29-37 of copending Application No. 10/433,119. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant formulation is generic to and fully encompass that in the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claim 1-51 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No. 10/499,997. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant formulation is generic to and fully encompass that in the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen L. Pezzuto whose telephone number is (571) 272-1108. The examiner can normally be reached on 8 AM to 4 PM, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization

where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Helen L. Pezzuto
Primary Examiner
Art Unit 1713

hlp